

MAY 08 2007

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REMARKS

This is a full and timely response to the non-final Official Action mailed **February 8, 2007**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, the specification and various claims have been amended. Additionally, new claims 56-61 have been added, and original claims 15, 26 and 45-55 have been cancelled without prejudice or disclaimer. Thus, claims 1-14, 16-25, 27-44 and 56-61 are currently pending for further action.

Prior Art:

In the recent Office Action, claims 1-14, 17, 18, 20-32, 34, 35, 37-47, 49, 50-52 and 55 were rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent App. Pub. No. 2003/0058216 to Lacroix et al. ("Lacroix"). The other claims, 15, 16, 19, 33, 36, 48, 53 and 54 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Lacroix and U.S. Patent App. Pub. No. 20070014490 to Silverbrook et al. ("Silverbrook"). For at least the following reasons, these rejection are respectfully traversed with respect to the claims as amended in the present paper.

Initially, Applicant notes that Silverbrook is not necessarily valid prior art against the present application. Silverbrook is a publication of an application filed July 31, 2006. In contrast, the present application was filed December 2, 2003, about two and half years before the Silverbrook application.

40000-0047

10/726,850

The Silverbrook application is a continuation-in-part of an earlier application filed June 20, 2005, which was a continuation of an even earlier application filed November 12, 2002. Consequently, only that subject matter included in the November 12, 2002 application can be applied as prior art against the present application. However, the present Office Action fails to demonstrate that the cited teachings in Silverbrook on which the action relies were included in the November 12, 2002 filing and not added in the continuation-in-part filed June 20, 2005. Until such a showing is made on the record, Silverbrook cannot be applied as prior art against Applicant's claims.

In addition, assuming for the sake of argument that Silverbrook is valid prior art, the teachings of Lacroix and Silverbrook still fail to anticipate or render obvious Applicant's claims as presented in this paper.

Claim 1 now recites:

A wireless stylus comprising:
a housing;
a central processing unit (CPU) disposed in said housing;
a wireless communication receiver disposed in said housing and
communicatively coupled to said CPU, wherein said wireless communication receiver
is configured to receive haptic commands from a host computing device;
an actuator communicatively coupled to said central processing unit, wherein
said actuator is configured to produce a haptic sensation, said haptic sensation being
controlled by said CPU in response to said haptic commands; and
*a light emitting device communicatively coupled to said CPU, wherein said
light is configured to be illuminated in response to said haptic commands.*
(Emphasis added).

Claim 1 has been amended to include the language of cancelled claim 15. Claim 15 was rejected under in the recent Office Action under the combined teachings of Lacroix and Silverbrook. Consequently, it is assumed that such rejection would now apply to claim 1.

However, in contrast to claim 1, the combination of Lacroix and Silverbrook fails to teach or suggest the claimed stylus including a light emitting device that is selectively

40000-0047

10/726,850

illuminated in response to haptic commands. The recent Office Action concedes that Lacroix does not teach the claimed light emitting device. (Action of 2/8/07, p. 8). Consequently, the Action cites to Silverbrook. However, Silverbrook also fails to teach or suggest the claimed light emitting device that is illuminated in response to haptic commands.

Silverbrook teaches a light source (780) that is paired with a light detector (778). The force on an electronic stylus prevents light from the source from reaching the detector in proportion to that force. Consequently, the light detector (778) measures the force on the stylus. (Silverbrook, abstract). In this arrangement, the light source (778) is always illuminated to measure force. There is no relationship between the light source being illuminated and a haptic command as claimed.

Thus, the combination of Lacroix and Silverbrook fails to teach or suggest the claimed stylus that includes "a light emitting device communicatively coupled to said CPU, wherein said light is *selectively illuminated in response to said haptic commands*." (Emphasis added).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejection of claim 1 should be reconsidered and withdrawn.

Claim 17 has been amended as an independent claims and now recites:

A wireless stylus comprising:
a housing;
a central processing unit (CPU) disposed in said housing;
a wireless communication receiver disposed in said housing and
communicatively coupled to said CPU, wherein said wireless communication receiver
is configured to receive haptic commands from a host computing device;
an actuator communicatively coupled to said central processing unit, wherein
said actuator is configured to produce a haptic sensation, said haptic sensation being
controlled by said CPU in response to said haptic commands; and

40000-0047

10/726,850

a speaker disposed on said housing, wherein said speaker is communicatively coupled to said CPU driven by said CPU to produce sounds in response to said haptic commands.

(Emphasis added).

In contrast, Lacroix fails to teach or suggest the claimed stylus with a speaker that produces sounds in response to haptic commands.

According to the Office Action, Lacroix teaches the claimed speaker at paragraph 0029. (Action of 2/12/07, p. 4). This, however, is incorrect. Lacroix teaches that a speaker voice coil may be used as a haptic actuator. (Lacroix, paragraph 0029). However, Lacroix does not teach or suggest the claimed speaker that produces sounds in response to haptic commands.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Lacroix of claim 17 should be reconsidered and withdrawn.

Claim 37 recites:

A wireless stylus comprising:
a means for housing components;
a means for processing data, said processing means being disposed in said housing means and configured to process haptic commands;
a means for wireless communication disposed in said housing means for receiving said haptic commands and communicatively coupled to said processing means;
a means for actuating communicatively coupled to said processing means, wherein said actuating means is configured to produce a haptic sensation under control of said processing means in response to said haptic commands; and
an ink dispensing means for dispensing ink when said stylus is used as a writing instrument with an ink receiving medium.

(Emphasis added).

40000-0047

10/726,850

Support for the amendment to claim 37 can be found in Applicant's originally filed specification at, for example, paragraph 0049.

In contrast, the combined teachings of Lacroix and Silverbrook fail to teach or suggest the claimed stylus that includes both an actuating means for producing a haptic sensation and an ink dispensing means. In this regard, the Office Action acknowledges that Lacroix does not teach or suggest a replaceable ink cartridge. (Action of 2/12/07, p. 8). Consequently, the Office Action argues that Silverbrook teaches a replaceable ink cartridge. (*Id.*).

To support the proposed combination of prior art, the Office Action argues that both Lacroix and Silverbrook teach haptic feedback devices. (*Id.*). This is incorrect. Silverbrook does not teach or suggest a haptic feedback device. Rather, Silverbrook teaches a stylus that measures the force applied on the stylus. (Silverbrook, abstract). Silverbrook has nothing to do with and does not mention haptic feedback.

Consequently, there is no reason why one of skill in the art would have been lead to combine the replaceable ink cartridge of Silverbrook with the haptic feedback device of Lacroix as proposed by the Office Action. "A patent [or patent application claim] composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." According to the Supreme Court, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR International Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007)).

40000-0047

10/726,850

For at least these reasons, the proposed combination of Lacroix and Silverbrook would not have taught or suggested the invention of claim 37 to one of ordinary skill in the art. Therefore, the rejection of claim 37 should be reconsidered and withdrawn.

Claim 41 recites:

A method for producing force feedback in an input device comprising:
receiving location data in a host computer from a user input device;
controlling a cursor on a display of said host computer with said location data from said user input device;
if said cursor controlled in response to said location data intersects another item displayed on said display, generating a haptic command corresponding to said item intersected by said cursor;
transmitting said haptic command corresponding to said item intersected to said user input device; and
with an actuator of said user input device, generating haptic sensations in response to said haptic command corresponding to said item intersected by said cursor.

In contrast, the cited prior art does not teach or suggest the claimed method that includes a cursor controlled in response to location data from a user input device where, "if said cursor controlled in response to said location data intersects another item displayed on said display, [the claimed method includes] generating a haptic command corresponding to said item intersected by said cursor." The cited prior further fails to teach or suggest the claimed method including "transmitting said haptic command corresponding to said item intersected to said user input device; and with an actuator of said user input device, generating haptic sensations in response to said haptic command corresponding to said item intersected by said cursor."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegual Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed.

40000-0047

10/726,850

Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Lacroix of claim 41 and its dependent claims should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 18 recites "wherein said sound is associated with said haptic sensation." In contrast, the cited prior art does not teach or suggest producing sound associated with a haptic sensation. Claim 35 recites similar subject matter. For at least this additional reason, the rejection of claims 18 and 35 should be reconsidered and withdrawn.

Claim 33 recites "a light emitting diode (LED) communicatively coupled to said CPU, wherein said LED is configured to illuminate in response to said haptic commands." As demonstrated above, the cited prior art fails to teach or suggest an LED configured to illuminate in response to haptic commands. For at least this additional reason, the rejection of claim 33 should be reconsidered and withdrawn.

Claim 36 recites "a replaceable ink cartridge disposed in said housing; wherein said replaceable ink cartridge may be selectively positioned to mark an ink receiving medium." In contrast as demonstrated above, the cited prior art does not teach or suggest the claimed combination of a replaceable ink cartridge in a haptic feedback stylus. For at least this additional reason, the rejection of claim 36 should be reconsidered and withdrawn.

40000-0047

10/726,850

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Conclusion:


The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims.

Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: May 8, 2007


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